

REMARKS

Claims 1-12 were pending in this application.

Claims 1-12 have been rejected.

Claims 1, 2, 5-8, and 10-12 have been amended as shown above.

Claims 13-20 have been added.

Claims 1-20 are now pending in this application.

Reconsideration and full allowance of Claims 1-20 are respectfully requested.

I. REJECTION UNDER 35 U.S.C. § 102

The Office Action rejects Claims 1-10 and 12 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,490,681 to Kobayashi et al. ("*Kobayashi*"). This rejection is respectfully traversed.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. (*MPEP* § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990)). Anticipation is only shown where each and every limitation of the claimed invention is found in a single prior art reference. (*MPEP* § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985)).

Kobayashi recites a system for replacing visible watermarks with invisible watermarks. (*Abstract*). In the system, a key is used to embed and remove the visible watermark and is

transmitted with watermarked content. (*Col. 3, Line 65 – Col. 4, Line 6; Col. 8, Lines 21-23*). The key includes a keyword, a start position, a watermark size, and a watermark dot pattern. (*Col. 4, Lines 7-10*).

Kobayashi simply recites that a key is used to embed and remove a visible watermark. *Kobayashi* lacks any mention that a visible watermark or an invisible watermark contains a “command” that is “to be executed by [a] controllable device” as recited in Claim 1. While the key of *Kobayashi* may be used to remove a visible watermark, the key does not represent a “command” that is “to be executed by [a] controllable device.” Moreover, the key is not part of the visible watermark. Because the key is not part of the visible watermark, the key of *Kobayashi* cannot anticipate a “watermark comprising [a] command” that is “to be executed by [a] controllable device” as recited in Claim 1. For these reasons, *Kobayashi* fails to anticipate all elements of Claim 1 (and its dependent claims).

Claim 6 recites “embedding means for generating a watermark comprising a command, which is to be executed by [a] controllable device.” Claim 7 recites “embedding means for generating a watermark comprising [a] command, which is to be executed by [a] controllable device.” Claim 8 recites “decoding means for obtaining an information unit from [a watermarked] signal and obtaining [a] command from a watermark in the information unit.” Claim 10 recites “generating a watermark comprising a command, which is to be executed by [a] controllable device.” Claim 12 recites a signal comprising “an information unit in which a watermark is embedded, the watermark comprising a command to be executed by a controllable device.”

As described above, *Kobayashi* fails to anticipate a “watermark” that includes a “command” to be executed by a controllable device. For these reasons, *Kobayashi* fails to anticipate all elements of Claims 6-8, 10, and 12 (and their dependent claims).

Accordingly, the Applicants respectfully request withdrawal of the §102 rejection and full allowance of Claims 1-10 and 12.

II. REJECTION UNDER 35 U.S.C. § 103

The Office Action rejects Claim 11 under 35 U.S.C. § 103(a) as being unpatentable over *Kobayashi*. This rejection is respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. (*MPEP* § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992)). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. (*MPEP* § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984)). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. (*MPEP* § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993)). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. (*In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re*

Grabiak, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985)).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. (*In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993)). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. (MPEP § 2142).

Claim 11 depends from Claim 10. As described above in Section I, Claim 10 is patentable. As a result, Claim 11 is patentable due to its dependence from an allowable base claim.

Accordingly, the Applicants respectfully request withdrawal of the § 103 rejection and full allowance of Claim 11.

III. NEW CLAIMS

The Applicants have added new Claims 13-20. The Applicants respectfully submit that no new matter has been added. The Applicants respectfully request entry and full allowance of Claims 13-20.

IV. CONCLUSION

As a result of the foregoing, the Applicants assert that the claims in this application are in condition for allowance and respectfully request allowance of such claims.

SUMMARY

If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Applicants respectfully invite the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@davismunck.com*.

The Applicants have included the appropriate fee to cover the cost of the AMENDMENT AND RESPONSE. The Applicants have also included the appropriate fee to cover the cost of a one (1) month extension of time. The Commissioner is hereby authorized to charge any additional fees connected with this communication (including any extension of time fee) or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

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